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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Marco Ooms

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RANKIN, HILL & CLARK LLP
23755 Lorain Road - Suite 200
North Olmsted, OH 44070-2224

EXAMINER

LOEWE, ROBERT S

ART UNIT

PAPER NUMBER

1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,883	Applicant(s) OOMS ET AL.	
	Examiner ROBERT LOEWE	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 2,4 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-8 and 10-17 is/are rejected.
- 7) ☒ Claim(s) 1,10 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/28/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities: "adhesive Is" on line 6 should be corrected to --adhesive is--.

Claim 10 is objected to because of the following informalities: "p. wt." is awkward and should be amended to something along the lines of --parts by weight--.

Claim 18 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n) (more specifically, (A.)(3.)). Accordingly, the claim 18 has not been further treated on the merits.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation "A2", "B2" and "C2". There is insufficient antecedent basis for this limitation in the claim. Applicants should either (1) amend instant claim 3 such

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that A2, B2 and C2 are written as --A--, --B--, and --C--, or (2) amend instant claim 1 such that "A)", "B)" and "C)" are written as --A)--, --B)--, and --C)--.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 provides for the use of a pressure sensitive adhesive, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims 1, 3, 5-8, 10, 11 and 14-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, component (D) of instant claim 1 recites that "the content of the T- and Q-units is more than 10 mol% of all siloxy units". However, it is unclear if both the T units and Q units are each present in more than 10 mol% or if the combination of all T and Q units are each present in more than 10 mol%. Based on Applicants specification, component (D) is prepared via condensation of an MQ resin and a linear silanol (which consists essentially of D units). There is nothing in the starting materials which would suggest >10 mol% of T units, nor is there believed to be anything inherent in the reaction

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chemistry which would yield final condensates having >10 mol% of T units. For purposes of further examination, it will be interpreted that the total amount of T and Q units is collectively greater than 10 mol%.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Greenberg et al. (US Pat. 6,387,487).

Greenberg et al. teaches using curable siloxane compositions as pressure sensitive adhesives in which a pressure sensitive adhesive is added to a curable siloxane composition followed by curing (Example 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 5-8, 11 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg et al. (US Pat. 6,387,487).

Claims 1, 3 and 5-8: Greenberg et al. teaches a curable, low-solvent silicone coating composition comprising an alkenyl-terminated polydiorganosiloxane [component (A) of Greenberg et al., reads on component A and A2 of claims 1 and 3], and organohydrogenpolysiloxane [component (D) of Greenberg et al., reads on component B and B2 of claims 1 and 3], a hydrosilation catalyst [component (E) of Greenberg et al., reads on component C and C2 of claims 1 and 3], a silanol-terminated polydiorganosiloxane [component (B) of Greenberg et al.] and a resinous copolymer, which is an MQ resin [component (C) of Greenberg et al.]. Components (B) and (C) are taught to be free of functional groups which would react with the addition curable compounds [components (A) and (D) of Greenberg et al.] which satisfies instant claim 5. Greenberg et al. teaches condensation of components (B) and (C), which satisfies instant claim 6 (example 1). The alkyl substituents of both components (B) and (C) are preferred to be methyl. While Greenberg et al. does not explicitly teach that the condensation reaction product of components (B) and (C) yield an adhesive compound which has greater than 10 mol% of T and Q-units as well as greater than 10 mol% of D units, Greenberg et al. does teach the same silanol-terminated polysiloxane gums as Applicants. The

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viscosity of the silanol-terminated polysiloxane gums is taught to be from about 100,000 to about 750,000 cPs (4:38). The viscosity of prepolymer [V] as taught in Applicants specification, which is believed to represent the same compounds as component (B) of Greenberg et al., is taught to preferably be from 100,000 to 2,000,000 mPa·s (cPs). Regarding the MQ resin [component (C) of Greenberg et al., MQ resin [H] as taught in Applicants instant specification], both Greenberg et al. and the instant specification cite the same US Pat. (2,676,182 to Daudt et al.) as a means to prepare such MQ resins (paragraph 0329 of Applicants instant pre-grant publication 2007/0275255 and 5:10-18 of Greenberg et al.). Since components (B) and (C) as taught by Greenberg et al. substantially overlap with the teachings of prepolymer [V] and MQ resin [H] in Applicants instant specification, it is the position of the Examiner that Greenberg et al. renders obvious the preparations of condensation products of polysiloxane gums and MQ resins which would inherently possess Applicants desired D, T and Q contents of instant claim 1 as well as Applicants claimed D:Q ratios of instant claims 7 and 8.

Claims 11 and 14-17: The composition of instant claim 1 is taught to be applied to a substrate and cured in Example 1 of Greenberg et al., which satisfies the limitations of instant claims 11 and 14-17. Greenberg et al. further teaches peel adhesion of the applied films, which is indicative of the substrate being released from the cured film as required by instant claim 16.

Claims 1, 3, 6-8, 10, 11 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (US Pat. 3,527,655) in view of Ko et al. (US Pat. 5,308,887).

Claims 1, 3 and 6-8: Ballard teaches curable silicone adhesive compositions comprising an vinyl chain-stopped polysiloxane [compound (1) of Ballard which reads on component A and

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A2 of claims 1 and 3], an organohydrogenpolysiloxane [compound (5) of Ballard which reads on component B and B2 of claims 1 and 3], a platinum hydrosilylation catalyst [component (4) of Ballard which reads on compound C and C2 of claims 1 and 3], and an MQ resin [compound (2) of Ballard] which serves to impart tack/adhesiveness to the compositions. While Ballard does not teach that the MQ resin may be a condensate or an addition product of an MQ resin and a substantially linear end-functional polysiloxane gum as required by instant claim 6, which would result in a product having M units, Q units and D units, Ko et al. teaches silicone pressure sensitive adhesives which preferably comprise silicone resins (MQD resins) containing silicon bonded alkenyl groups (8:60-9:5). Ko et al. further teaches that such condensates (addition products) based on the reaction of MQ resins with linear polysiloxane gums yields improvements in the adhesive properties of the resins (9:9-12). Ballard and Ko et al. are combinable because they are from the same field of endeavor, namely, silicone adhesive compositions. At the time of the invention, it would have been obvious to a person having ordinary skill in the art to employ an MQD resin as the adhesive ingredient as taught by Ko et al. in lieu of the MQ resin as taught by Ballard and would have been motivated to do for the reasons taught by Ko et al. above (9:9-12). Based on the teachings of Ko et al., the polydiorganosiloxane gums possess viscosities similar to prepolymer [V] of Applicants specification and the MQ resin possesses similar M:Q ratios as MQ resin [H] of Applicants specification. Therefore, reaction products between these ingredients would be expected to yield MDQ resins which satisfy the required content of D and Q units as required by instant claim 1 as well as the D:Q ratio as required by instant claims 7 and 8.

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Claim 10: Ballard teaches that for 100 parts of component (1) there is from 0 to 50 parts of MQ resin. The catalyst (4:5) and organohydrogenpolysiloxane crosslinker (example 2) are taught to be added in amounts which satisfy instant claim 10. Replacement of the MQ resin with the MDQ resin as described above would yield a teaching of from 0 to 50 parts of MDQ resin, which encompasses the claimed range of 0.01 to 10 parts by mass of component D.

Claims 11 and 14-17: Ballard teaches applying the compositions taught therein onto a substrate, thereby satisfying instant claims 11, 14, 15 and 17. While Ballard does not explicitly teach applying the compositions to a substrate which is to be released as required by instant claim 16, such a limitation is directed to a future intended use. It is believed that the compositions taught by Ballard, once applied to a substrate and cured, could be removed from (released by) the substrate.

Relevant Art Cited

Additional prior art documents which are relevant to Applicants invention can be found on the attached PTO-892 form.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Loewe/
Patent Examiner, Art Unit 1796
21-Apr-10